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Docket No. 188/167

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ANTHONY MAGLICA

Serial No.: 07/411,576

APPEAL NO. #39

Filed: September 22, 1989

For: FLASHLIGHT

Group Art Unit: 291

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TRANSMITTAL OF APPEAL BRIEF

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

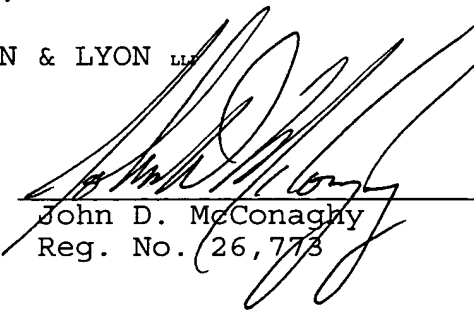
Enclosed herewith is an Appeal Brief for the above-identified application.

- X Check in the amount of \$145.00 is enclosed.
- X An Oral Hearing was previously requested (two additional copies of the Brief are enclosed).
- X The Commissioner is hereby authorized to charge payment of the fees associated with this communication, or credit any overpayment, to Deposit Account 12-2475.
- X I hereby certify that this paper and an APPEAL BRIEF (along with anything else referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date of signature hereof with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

LYON & LYON LLP

September 5, 1996

By


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:

ANTHONY MAGLICA

Serial No. 07/411,576

Filed: September 22, 1989

For: MINIATURE FLASHLIGHT

) Art Unit: 2901

) Examiner: M. Tung

RECEIVED
SEP 27 1996
GROUP 2900

APPEAL BRIEF

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This brief is an appeal from the final rejection of Applicant's design claim in the Office Action dated December 5, 1995. The pending application and claim are anticipated to be properly formed and the issues distilled and ripe for appeal.

STATEMENT OF INTEREST

The real party in interest for Applicant Anthony Maglica is Mag Instrument, Inc., a California Corporation.

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STATEMENT OF RELATED APPEALS

The pending application is related to U.S. Design Application, Serial No. 07/410,965, also filed on September 22, 1989 and which is also on appeal before the Board of Patent Appeals and Interferences.

STATUS OF CLAIM

The design claim on appeal was finally rejected on December 5, 1995 under 35 U.S.C. § 103 as being unpatentable over Maglica, U.S. Patent No. 4,658,336 in view of Huang, U.S. Patent No. 4,750,095.

The design claim was also finally rejected under 35 U.S.C. § 112, first paragraph. The Official Action stated that the then pending formal drawings introduced new matter that was not disclosed in the application's original drawings.

The present application was previously on appeal before the Board which affirmed, with additional new grounds, the Examiner's prior final rejection. Pursuant to 37 C.F.R. § 1.196(b)(1), Applicant elected to continue prosecution before the Examiner, who subsequently entered another final rejection in the December 5, 1995 Official Action.

STATUS OF AMENDMENTS AFTER FINAL REJECTION

The design claim on appeal reflects an Amendment After Final Rejection filed on February 27, 1996. Subsequent submissions and discussions with the Examiner have been undertaken. Currently, a Third Amendment After Final Rejection has been submitted,

received on September 5, 1996, which included new formal drawings and a Substitute Declaration of Gerald R. Parker. The point of this and prior such submissions was to comply with each requirement of the Examiner so that no issue remained with the exception of the issue of the discontinuity on the head. The presently pending informal drawings are shown in Exhibit I attached hereto. The formal drawings submitted on September 5, 1996 is shown in Exhibit II attached hereto. In drawings of Exhibits I and II, the head is substantially identical and raises the issue appealed here.

SUMMARY OF THE INVENTION

The present invention relates to the candle mode design of a flashlight. The pending design application is a division of a utility patent application, Serial No. 456,361, filed on May 23, 1989, which issued as U.S. Patent No. 4,942,505 and which is a continuation of several utility patent applications, including the original parent utility application, Serial No. 648,032, filed on September 6, 1984, which issued as U.S. Patent No. 4,577,263. Pursuant to 35 U.S.C. § 120, Applicant claims the benefit of the earlier United States filing date of the original parent application, September 6, 1984, for the present application.

ISSUES

This appeal is directed to the shape of the flashlight head depicted in the presently pending informal drawings of Exhibit I, the proposed formal drawings of Exhibit II and the drawings in the original parent application, attached for convenience as Exhibit III. The

remaining points of concern expressed in the Advisory Action of March 19, 1996 are not contested. Repeated efforts have been made to satisfy each requirement raised by the Examiner. It is anticipated that the drawings submitted and attached here as Exhibit II now satisfy all other requirements.

The present design claim stands finally rejected under 35 U.S.C. § 103 as being unpatentable over two cited references. These references would not qualify as prior art except that the Official Action dated December 5, 1995 stated that the present application is not entitled to the benefit of the filing date of its original parent application under 35 U.S.C. § 120. If the present application is granted the benefit of continuity, then the references would be antedated and the rejection would be overcome. Thus, the issue on appeal is whether the present design application is entitled, under 35 U.S.C. § 120, to the benefit of the filing date of its original parent utility application, Serial No. 07/648,032.

This issue under § 120 essentially reduces down to a straightforward question: whether the original parent application adequately discloses the presently claimed invention under 35 U.S.C. § 112, first paragraph. Specifically, the question becomes whether the curved profile of the flashlight head in the present drawings was disclosed adequately in the original parent application to persons of ordinary skill in the art.

GROUPING OF CLAIMS

Since only a single claim is permitted in a design patent application, the grouping of claims is not applicable in the present case.

ARGUMENT

THE BACKGROUND

The present application is ultimately based on a utility application filed on September 6, 1984. The application as first filed included four figures, Figures 1, 2, 3 and 8, which illustrated flashlight heads at issue. (See Exhibit III.) Two design applications have been filed, one on the flashlight as configured in Figure 1 of the original application and the present application on the flashlight as configured in Figure 8 of the original application, the "candle mode".

Original Figure 1, directed to the flashlight mode was incorrectly drawn. It included a circumferential line about the head conventionally understood to represent a line of surface discontinuity. No such line or discontinuity appears in any of the other original figures. Original Figure 8, which provides the basis for the candle mode configuration of the present application, does not directly show the surface in question as a portion is broken away. The break depicted in this original figure fails to show any surface discontinuity at any point that would make the drawings consistent with original Figure 1. Such a showing of discontinuity would be customary in a cross section if a surface discontinuity were present. Original Figures 2 and 3 show cross sections of a flashlight head. These cross sections also fail to show any surface discontinuity and are, therefore, also inconsistent with original Figure 1.

Two rejections are presented. The rejection under 35 U.S.C. § 103 is based on "prior art" which have effective dates after the original filing in 1984. The rejection under 35 U.S.C. § 112, first paragraph is based on the insistence that Figure 1 of the 1984

drawings must be followed. These rejections are overcome by the depictions in original Figures 2, 3 and 8 which support the disclosure of a flashlight head used in the candle mode with a curved surface of revolution without surface discontinuity and provide continuity under 35 U.S.C. § 120. With support from the original filing of 1984, the references are too recent to be prior art and the present figures satisfy the first paragraph of § 112.

THE ISSUE

Ultimately, the issue is the applicability of 35 U.S.C. § 120 to the present application with the drawings as presented in Exhibits I and II. The final rejection under 35 U.S.C. § 103 is based on Maglica (4,658,336) in view of Huang (4,750,095). Both references are antedated by the original application to which priority is claimed in the present case. Consequently, the issue of 35 U.S.C. § 103 is resolved if 35 U.S.C. § 120 is satisfied. Similarly, 35 U.S.C. 112, first paragraph, is resolved if the present drawings of Exhibits I and II are recognized as supported by the original drawings of the priority application, Exhibit III. The December 5, 1995 Official Action states that the application was not entitled to the benefit of continuity under § 120 because the shape of the flashlight head in the present application appeared to be different than the shape of the flashlight head shown in its original parent application. Accordingly, the following presentation will focus on § 120 as satisfied by compliance with § 112, first paragraph.

In order to claim the benefit of an earlier filing date, the presently claimed invention must have been disclosed in its original parent application in the manner required by the first paragraph of 35 U.S.C. § 112. Racing Strollers Inc. v. TRI Industries, 11 U.S.P.Q.2d

1300, 1301 (Fed. Cir. 1989) (citing 35 U.S.C. § 120). In Racing Strollers, the Federal Circuit held that a design application could claim the benefit of the filing date of an earlier filed utility application and further stated:

As a practical matter, meeting the remaining requirements of § 112 is, in the case of an ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein by the prescribed formal claim.

11 U.S.P.Q.2d at 1301 (Emphasis Added).

Whether a patent application adequately describes the claimed subject matter in the manner required by the first paragraph of § 112 is a question of fact. In re Alton, 37 U.S.P.Q.2d 1578, 1580 (Fed. Cir. 1996). If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, then the description requirement of § 112 is met. In re Alton, 37 U.S.P.Q.2d at 1584.

With respect to meeting the description requirement of § 112, an applicant is entitled to submit competent declarations indicating how § 112 has been satisfied by showing that persons of ordinary skill in the art would have realized that the applicant was in possession of the claimed invention based on the original application. In re Alton, 37 U.S.P.Q.2d at 1584. In determining whether the description requirement of § 112 has been satisfied, the Examiner as well as the Board is required to consider the totality of the record, including fact declarations and other evidence submitted by the applicant which show that persons of

ordinary skill in the art would have realized the applicant possessed the invention at the time the original application was filed. In re Alton, 37 U.S.P.Q.2d at 1584.

In this case, the Official Action dated December 5, 1995 specifically stated that the presently claimed design included a flashlight head with an outer profile having a curved portion while the original parent application depicted the flashlight head with an angled surface having a relatively sharp juncture where a tapered portion meets a cylindrical portion.

THE ORIGINALLY DISCLOSED HEAD

Figures 2, 3 and 8 of the original parent application (Exhibit III) show a flashlight head having a curved portion. Although Figures 2 and 3 are section views of the flashlight for purposes of the utility disclosure, they actually show the greatest amount of detail of the flashlight head shape. Moreover, because of the symmetrical nature of the flashlight head, Figures 2 and 3 each completely describe the curved profile of the flashlight head to persons of ordinary skill in the art. Figure 8 also shows a head and provides basis for the candle mode arrangement of the present application. Figure 8 lacks the surface where to line would or would not be because of a broken out portion of the head to illustrate the position of the end cap in the head. Drawing practice before the PTO would have the discontinuity reflected in the outer edge of the cut portion. No such discontinuity exists. Adequate support for the present head configuration in Exhibits I and II, therefore, exists in original Figures 2, 3 and 8. The perspective view in Figure 1 of the original drawings depicts a surface discontinuity in the flashlight head as seen by the parting line, previously designated Bd1 in the prior

appeal. This mistaken line in Figure 1 is an inconsistency with detailed Figures 2 and 3 and candle mode Figure 8.

In its prior decision in this case, the Board relied on In re Salmon, 217 U.S.P.Q.2d 981 (Fed. Cir. 1987) in support of its holding that the present application was not entitled to the benefit of continuity under 35 U.S.C. § 120. In In re Salmon, a case involving a bar stool design, the Federal Circuit based its holding that the requirements of § 120 had not been met on the fact that the alternative of the claimed round seat was not found in the parent application and that the parent application did not suggest a different seat configuration other than the square seat shown in the parent.

In the present case, however, the alternative of a flashlight head having a curved portion is shown in the parent application in both Figures 2 and 3. This fact is confirmed by the expert declarations previously submitted by the Applicant and discussed below. By refusing to grant the present application the benefit of the filing date of its parent application, the Applicant is erroneously confined to the specific embodiment of the flashlight head shown only in Figure 1 of the parent application and is denying Applicant the right to claim the embodiment of the flashlight head shown in Figures 2 and 3 of the parent application.

To demonstrate that § 112, first paragraph has been satisfied, Applicant has submitted with the Response Pursuant to 37 C.F.R. § 1.196(b)(1) competent and compelling declarations from two experts, Mr. Martin Siegel and Mr. Jack Miller. Both Mr. Siegel and Mr. Miller stated that the flashlight heads depicted in the original Figures 2 and 3 clearly include curved portions that persons having ordinary skill in the art would recognize. These

declarations confirm that the presently claimed design is disclosed by the original parent application in the manner required by § 112, first paragraph. It should be noted that Mr. Siegel and Mr. Miller are experts in the fields of mechanical design and flashlight design, respectively, and thus clearly understand what persons having merely ordinary skill in the art would learn from the original parent application. In re Mahurkar, 28 U.S.P.Q.2d 1801, 1807 (N.D. Ill. 1993), aff'd, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) ("[T]he leaders of a field understand something about how the median members of the discipline think.")

Mr. Siegel examined the profile of the head of the flashlight shown in Figure 2 of the original parent application and compared it with the same head shape as that shown in the present drawings.^{1/} Mr. Siegel observed that the profile of the flashlight head shown in Figure 2 of the original parent drawings clearly includes a curved portion and is not defined by the intersection of two straight lines. (Siegel Declaration, ¶ 8-9). Because the profile of the flashlight head includes a curved portion, it would be incorrect to show a parting line as in Figure 1 of the original drawings on the surface of the flashlight head. (Siegel Declaration, ¶ 10). Mr. Siegel also determined that the shape of the flashlight head shown in Figure 1 of the original drawings is inconsistent with the shape of the flashlight head shown in Figures 2 and 3 of the original parent application and that persons having ordinary skill in the art would recognize the inconsistency. (Siegel Declaration, ¶¶ 11-12).

^{1/} The shape of the flashlight head shown in the drawings referred to in the Siegel and Miller declarations as the "present drawings" is the same as the shape of the flashlight head shown in the drawing filed February 27, 1996 as presently pending in this application and the drawing presented September 5, 1996. (See discussion, *infra*, of McAlister, Plumb and Parker declarations.)

Mr. Miller also examined the shape of the flashlight head shown in Figure 2 of the original parent drawings and found that a person having ordinary skill in the art of flashlight design would recognize that the profile of the head shown in Figure 2 clearly includes a curved portion and that Figure 2 supports the shape of the flashlight head shown in the present drawings. (Miller Declaration, ¶ 8). Mr. Miller further noted that because the flashlight head includes a curved portion, it would be incorrect to show a parting line as in Figure 1 of the original drawings on the surface of the flashlight head. (Miller Declaration, ¶ 9). Lastly, Mr. Miller concluded that the angled shape of the flashlight head shown in Figure 1 of the original parent application would be recognized by a person having ordinary skill in the art of flashlight design as being inconsistent with the curved shape of the flashlight head shown in figures 2 and 3 of the original parent utility application. (Miller Declaration, ¶ 10).

The Board of Patent Appeals held in the prior appeal that the deletion of the line of discontinuity in Figure 1 of the original drawings is not supported by the original application. (Decision, p. 18.) In reaching its decision, the Board did not address the overlay comparison submitted by the applicant as Exhibits I and II in the prior appeal. Applicant submits that these exhibits establish, along with the declarations of Mr. Siegel and Mr. Miller referenced above, that the head shape of the flashlight in the present drawings is the same as the head shape of the flashlight shown in Figures 2 and 3 of the original drawings. Consideration of the overlay comparisons is requested.

THE CURRENT HEAD

In addition to the Siegel and Miller declarations, Applicant has previously submitted other declarations which demonstrate that the shape of the flashlight head in the present design is the same as that shown in the original parent application drawings.

The August 23, 1993 declarations of Mr. Fred McAlister and Mr. Robert Plumb were submitted by Applicant with the Response Pursuant to 37 C.F.R. § 1.196(b)(1). These declarations establish that the formal drawings filed with the 1.196(b)(1) Response, as well as the formal drawings that were pending before the Board during the first appeal, depict the same flashlight head shape as that shown in Figure 2 of the original parent application.

Exhibit A of the August 23, 1993 McAlister declaration is a copy of the original parent application drawings. Exhibit B of that declaration is a copy of the formal drawings produced by Mr. McAlister for Applicant's companion design application, Serial No. 07/410,965 and which were filed therein on May 29, 1991. The Exhibit B drawings were produced using the process described in the May 28, 1991 McAlister declaration and reiterated in the August 23, 1993 declaration. (McAlister Declaration, ¶ 7). The Exhibit B drawings are also the same drawings that were examined by Mr. Miller and Mr. Siegel for their declarations. Mr. McAlister's declaration describes how he personally created a computer aided design (CAD) reproduction of the flashlight head profile shown in Figure 2 of the original parent application and used this reproduction to create the Exhibit B drawings without altering the flashlight head shape. As a result, the drawings in Exhibit B have the same head shape as that shown in Figure 2 of the original application, a fact confirmed by

both the Siegel and Miller declarations as well as by the transparency overlays previously submitted by Applicant. (Siegel Declaration, ¶ 9; Miller Declaration, ¶ 8; McAlister Declaration, ¶ 8).

The drawings that were pending before the Board during the first appeal of the present application were produced by Mr. Plumb under the supervision of Mr. McAlister. (McAlister Declaration, ¶ 9; Plumb Declaration, ¶ 4). These drawings, submitted to the PTO on December 13, 1991 and referred to as the Appendix II drawings by the Board, were created using the same CAD program used to produce the Exhibit B drawings, again without changing the shape of the flashlight head. (McAlister Declaration, ¶ 9; Plumb Declaration, ¶ 4). As a result, the shape of the flashlight head in the December 13, 1991 Appendix II drawings is the same as the shape of the flashlight heads in both the Exhibit B drawings and in Figure 2 of the original parent application. (McAlister Declaration, ¶ 9).

New formal drawings for the present application were filed with Applicant's 1.196(b)(1) Response, and were attached to the August 23, 1993 McAlister declaration as Exhibit C. These drawings were also produced by Mr. Plumb under the supervision of Mr. McAlister. (McAlister Declaration, ¶ 11; Plumb Declaration, ¶ 3). As with the December 13, 1991 Appendix II drawings, the Exhibit C drawings were created using the same CAD program used to create the Exhibit B drawings, again without changing the shape of the flashlight head, and thus have the same flashlight head shape as the previous drawings and Figure 2 of the original parent application. (McAlister Declaration, ¶ 12; Plumb Declaration, ¶ 3).

On February 27, 1996, informal drawings attempting to comply with the Examiner's requirements were submitted (Exhibit I). This sheet of drawings simply employed the prior drawings submitted with the Response Pursuant to 37 CFR 1.196(b)(1) with changes marked in red. The September 5, 1996 Substitute Declaration of Gerald R. Parker, submitted with Applicant's Third Amendment After Final Rejection, along with the drawings of Exhibit III, establishes that the drawings now pending in this application as of February 27, 1996 have the same flashlight head shape as the drawings described in the McAlister, Plumb, Siegel, and Miller declarations. In his declaration, Mr. Parker states that he personally prepared the set of drawings showing proposed changes that were filed on February 27, 1996 with the Amendment After Final Rejection. (Parker Declaration, ¶ 3). Mr. Parker created these drawings by manually drawing the proposed changes in red ink on a copy of the prior pending formal drawings (Exhibit C in the August 23, 1993 McAlister Declaration) which had been filed with the Response Pursuant to 37 C.F.R. § 1.196(b)(1). (Parker Declaration, ¶ 4). In making these changes, Mr. Parker did not alter the shape of the flashlight head. (Parker Declaration, ¶ 5).

Lastly, on September 5, 1996, Applicant filed the presently submitted formal drawings with the Third Amendment After Final Rejection. The Parker Declaration submitted with the Third Amendment states how Mr. Parker created the presently pending drawings by scanning into a CAD system the drawings filed on February 27, 1996 using a high resolution computer scanner. (Parker Declaration, ¶ 6). In creating the presently pending drawings, Mr. Parker did not alter the shape of the flashlight head from that shown

in the previous drawings. (Parker Declaration, ¶ 7). As a result, the presently pending September 5, 1996 formal drawings have the same flashlight head shape as the February 27, 1996 drawings as well as the Exhibit B and Exhibit C drawings from the August 23, 1993 McAlister declaration. (Parker Declaration, ¶¶ 7-8). Thus, the presently pending drawings (Exhibit I) and the presently submitted drawings (Exhibit II) also have the same flashlight head shape as that depicted in Figure 2 of the original parent application.

On December 17, 1991, Applicant's own declaration was filed. This declaration incorporated his previous declaration, executed August 9, 1991, which was filed in Applicant's companion design application, Serial No. 07/410,965. The Maglica declaration states that line in question in Figure 1 of the original parent utility application was the result of a drafting error which went unnoticed until after the resulting patent had issued. (August 9, 1991 Maglica Declaration, ¶ 7). This statement is confirmed by both the Siegel and Miller Declarations, both of which further note that persons having ordinary skill in the art would recognize the inconsistency between Figure 1 and Figures 2 and 3. (Siegel Declaration, ¶ 11; Miller Declaration, ¶ 10). The Board previously stated that the Maglica Declaration was lacking in probative weight because a drafting error does not excuse compliance from § 112. (June 23, 1993 Decision, p. 17). However, Applicant has never asserted that the description requirement of § 112 is diminished because of a drafting error such as here, nor was the Maglica Declaration offered to somehow avoid the requirements of § 112. Rather, the Maglica Declaration simply indicates that Figure 1 was incorrectly drawn resulting in the flashlight head in Figure 1 having a different shape (i.e. angled) than the

flashlight head in Figures 2 and 3 (curved). The fact that the flashlight heads shown in Figures 2 and 3 are curved is still further confirmed by Mr. Maglica's assertion that Mag Instrument has never manufactured or sold a Mini-Maglite® flashlight which did not have a flashlight head with a curved profile. (August 9, 1991 Maglica Declaration, ¶ 5).

Applicant's removal of the line in question in the present application merely represents Applicant's choice to claim the curved design of the flashlight head shown in Figures 2 and 3 of the original parent application. Moreover, the correction of the original drawing inconsistency between Figure 1 and Figures 2, 3 and 8 is permitted because the flashlight head shape was already disclosed in Figures 2, 3 and 8. Hadco Products, Inc. v. Lighting Corp. of America, 165 U.S.P.Q. 496, 503 (E.D. Pa. 1970), rev'd on other grounds, 174 U.S.P.Q. 358 (3d Cir. 1972), cert. denied, 175 U.S.P.Q. 678 (1972). In Hadco, the court held that drawing errors and inconsistencies which do not preclude the overall understanding of the drawings are not a adequate basis for holding the design insufficiently disclosed under § 112. Id. In that case, the patent holder introduced expert testimony, just as Applicant has here, that the claimed design met the requirements of § 112 despite the presence of errors and inconsistencies between the figures. The court noted that such testimony was "... strong evidence of compliance with the statutory and regulatory provisions ..." Id.

For all of these reasons, as well as the reasons previously asserted on the record and in the prior appeal, Applicant contends that the present design Application is entitled to the benefit of the filing date of its original parent utility application.

Conclusion

The final rejection based on the profile of the flashlight head is inappropriate because the present design application is legally entitled to the benefit of the filing date of its original parent utility application, predating the cited references and providing support for the curved profile in original application Figures 2, 3 and 8. Therefore, Applicant respectfully requests that the final rejections be reversed and that the present application be allowed.

Respectfully submitted,

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Date: September 5, 1996

By 

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APPENDIX

I claim:

5. The ornamental design for a miniature flashlight as shown and described.

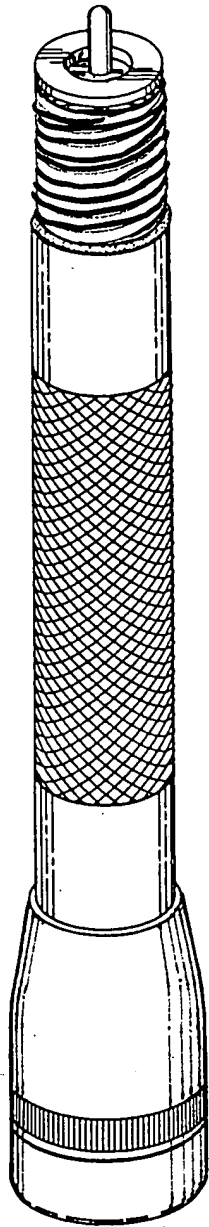


FIG. 1.

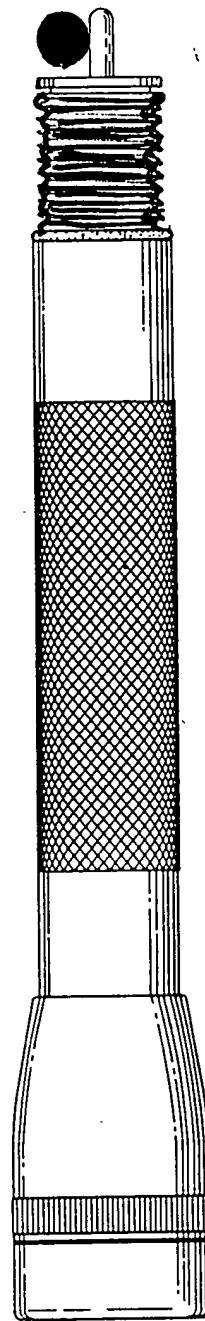


FIG. 2.

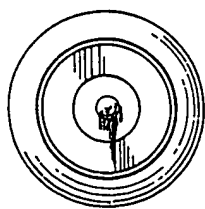


FIG. 3.

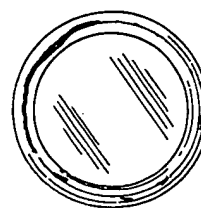


FIG. 4.

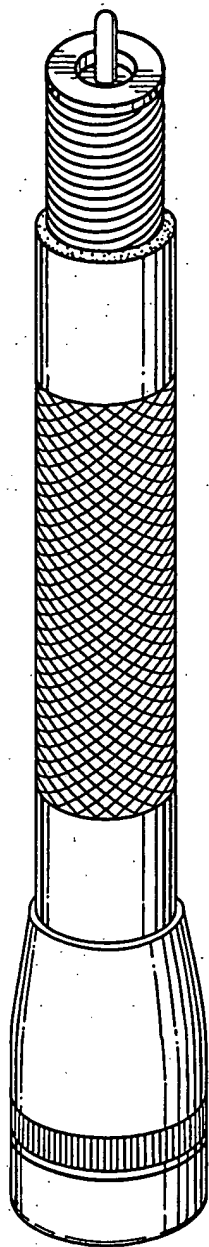


Fig. 1

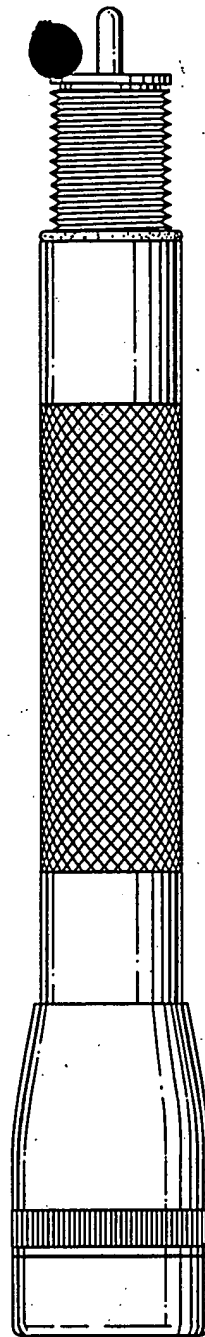


Fig. 2

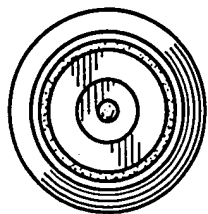


Fig. 3

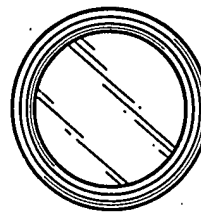


Fig. 4

